

REMARKS

Applicant has carefully reviewed the Application in light of the Office Action dated June 7, 2006. Claims 1-30 are pending and stand rejected. Claims 1, 12, and 21 have been amended. No new matter has been added with the amendments. Applicant respectfully requests reconsideration and favorable action in this case.

Section 101 Rejections

Claims 21-30 are rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter. The Office Action stated that "the language of claim 21 in view of the definition of the computer program product from the detailed description of the embodiments...recites carrier and signals which are not considered as tangible and do not form the basis of statutory subject matter." Applicant respectfully disagrees that the claims are not directed to statutory subject matter.

"Only when the claim is devoid of any limitation to a practical application in the technological arts should it be rejected under 35 U.S.C. 101." MPEP 2106 (II)(A). Independent claim 21 is directed to a "computer program product, tangibly embodied on an information carrier" and "grant[s] the accessor access to the at least one portion [of an electronic document] according to the access behavior." A computer program product embodied on an information carrier that grants an accessor access to at least a portion of an electronic document may be used by companies in their day-to-day operation. Applicant submits that a computer program that grants access to at least a portion of an electronic document is a practical application.

While an abstract idea by itself may not satisfy the requirements of 35 U.S.C. § 101, an abstract idea when practically applied to produce a useful, concrete, and tangible result satisfies 35 U.S.C. § 101. *See AT&T Corp. v. Excel Comm. Inc.*, 172 F.3d 1352, 1357 (Fed. Cir. 1999). "In determining whether the claim is for a 'practical application,' the focus is not on whether the steps taken to achieve a particular result are useful, tangible and concrete, but rather that the final

result achieved by the claimed invention is 'useful, tangible, and concrete.' Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility at 20.

Invention of Claim 21 Is Useful

The Interim Guidelines state that for an invention to have a useful result, the utility has to be specific, substantial, and credible. Claim 21 is directed to a computer program that grants access to at least a portion of electronic documents is a practical application and produces a specific, substantial, and credible result.

The Invention of Claim 21 is Tangible

The Interim Guidelines also state that to have tangible results, claims must set forth a practical application of the § 101 judicial exception to produce a real-world result. Interim Guidelines at 21 (*citing Gottschalk v. Benson*, 409 U.S. 63, 71-72, (1972) (invention ineligible because it had "no substantial practical application.")). For the reasons stated above, Applicant submits that claim 21 has substantial practical application. The Interim Guidelines also state that "the opposite meaning of 'tangible' is 'abstract.'" Interim Guidelines at 22. Claim 21 recites "grant the accessor access to the at least one portion according to the access behavior" which is not abstract.

The Invention of Claim 21 is Concrete

The Interim Guidelines indicate that to have a concrete result, a result must be substantially repeatable or substantially produce the same result again. Interim Guidelines at 22 (*citing In re Swartz*, 232 F.3d 862, 864 (Fed. Cir. 2000)). Applicant submits that the computer program product, tangibly embodied on an information carrier, comprising instructions operable to cause a data processing apparatus to grant the accessor access to the at least one portion according to the access behavior is substantially repeatable and hence produces a concrete result.

For at least the reasons stated above, Applicant submits that independent claim 21 and its dependent claims produce a useful, tangible, and concrete result and are, therefore, directed to statutory subject matter. Applicant respectfully requests that Examiner's rejection of Claims 1-21 under 35 U.S.C. § 101 be withdrawn.

Section 103 Rejections

Claims 1-30 are rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,599,324 to *Saito* et al. ("*Saito*") further in view of U.S. Patent No. 6,314,409 to *Schneck* ("*Schneck*"). Applicant respectfully disagrees that the claims are unpatentable over the cited art.

The *Saito* reference teaches a document management apparatus for managing perusal and editing of documents (*Saito*, Abstract). The *Saito* reference teaches that an access right setting means receives access privileges-specific information inputted by an access right manager (*Saito*, column 8, lines 12-15). The described access privileges-specific information includes information for specifying the structured document, information for specifying an accessor, and information indicative of a distinction between a permission of access for a document element and an inhibition of access for the document element (*Saito*, column 8, lines 15-22). Upon receipt of the described access privileges-specific information, the access right setting means directly sets up permission or inhibition of access right for the documents (*Saito*, column 8, lines 22-26). The described access rights setting means causes the display format control means to set up a display format of a document for each structured part of the document for each assessor ID so that a display document includes only a structured part which is permitted in access in accordance with the entered accessor ID (*Saito*, column 6, lines 6-18).

The *Schneck* reference teaches a data distributor and a user (*Schneck*, column 9, lines 40-41). The described data distributor takes data and produces packaged data which is provided to the user (*Schneck*, column 9, lines 41-43). The described packaged data may include access rules in encrypted form provided therewith or provided to the user separately (*Schneck*, column 9, lines 50-53). The described rules embody the data owner's control policies with respect to a

user's access rights to data (*Schneck*, column 22, lines 52-54). The described rules are preferably embodied in a permission list that consists of rules governing access made available by the owner to a particular user or group or class of users and defines the ways the user may and may not interact with the data (*Schneck*, column 22, line 62; column 23, lines 56-60).

Claim 1 recites "an access layer operable to control access to the electronic document" and "wherein the expert system provides authorization information to the access layer in response to a request." The Office Action states that "*Saito* does not disclose the rule set as claimed" (Office Action, page 3). The *Saito* reference also does not appear to teach an access layer operable to control access to an electronic document nor an expert system providing authorization information to an access layer in response to a request. The *Saito* reference appears to teach a manager inputting access privileges-specific information and the access right setting means directly setting up permission or inhibition of access right for the documents. The *Saito* reference also appears to teach the access rights setting means causing the display format control means to set up the display of the document. The *Saito* reference does not teach an access layer nor an expert system providing authorization information to an access layer in response to a request.

Applicant submits that *Schneck* also does not appear to teach or suggest an access layer operable to control access to an electronic document nor an expert system providing authorization information to an access layer in response to a request. Instead, the *Schneck* reference teaches a data distributor and data, wherein the data includes a rule set that determines a user's access to the data. The *Schneck* reference does not teach an access layer nor an expert system providing authorization information to an access layer in response to a request. Accordingly claim 1 and its dependent claims are allowable over the cited art.

Independent claims 12 and 21 recite receiving a request from an accessor to access at least one portion of an electronic document and, in response to receiving the request, requesting authorization information from an expert system with regards to the authorization of the accessor to at least one portion of the electronic document. Independent claims 12 and 21 also recite

receiving from the expert system the authorization information including an access behavior. *Saito* and *Schneck* do not teach in response to receiving a request from an accessor to access at least one portion of an electronic document, requesting authorization information from an expert system; nor do *Saito* and *Schneck* teach receiving from an expert system the authorization information including an access behavior. Instead, *Saito* teaches upon receipt of access privileges-specific information inputted by an access manager, setting up permission or inhibition of access right for the documents. *Schneck* teaches providing a user with packaged data that includes access rules, where the access rules define ways the user may or may not interact with the data. Accordingly, claims 12 and 21 and their respective dependent claims are also allowable over the cited art.

CONCLUSION

It is believed that all of the pending claims have been addressed. However, the absence of a reply to a specific rejection, issue or comment does not signify agreement with or concession of that rejection, issue or comment. In addition, because the arguments made above may not be exhaustive, there may be reasons for patentability of any or all pending claims (or other claims) that have not been expressed. Finally, nothing in this paper should be construed as an intent to concede any issue with regard to any claim, except as specifically stated in this paper, and the amendment of any claim does not necessarily signify concession of unpatentability of the claim prior to its amendment.

Applicant believes no fees are due in connection with this submission. If any extension of time is required, Applicant hereby requests the appropriate extension of time. Please apply any charges or credits to deposit account 06-1050.

Respectfully submitted,

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